REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested. Claims 1—25, 27—30, 33—48, 52—53, and 55 are pending.

I. The Rejections Under 35 U.S.C. §103(a)

In the Office Action, claims 1—8, 12—14, 27—30, 33—38 and 55 were rejected under 35 U.S.C. §103(a) over Starr (US 6,606,606) in view of Thomson (5,121,945). The Applicant respectfully traverses the rejection.

Starr describes management of plural financial accounts to perform plural financial transactions, with each transaction involving multiple sub-transactions among multiple financial service providers (Starr, col. 2, lines 52-57). The description of such a management system does not teach, or even suggest, aspects of the presently rejected claims. In particular, Starr does not teach or suggest "(issuance of) an instruction to have a check issued that includes an offer to receive future funds via an electronic financial account". Accordingly, the Patent Office invokes the Thomson reference. However, as will be seen, Thomson does not show this feature.

Thomson describes a financial management system wherein a creditor (e.g. a mortgage company) can send a bill to a debtor. As seen in column 3, lines 60—65, the innovative bill includes (1) the invoice; (2) a maintenance section wherein changes of address, account number etc. can be handled; and (3) a pre-printed bank check. Fig. 1C is an example. The recipient receives the bill, notes the amount of the invoice, verifies that all account numbers are unchanged, and signs the check, which is then returned to the mortgage company. The unusual feature,

generally, is the fact that the recipient does not use the recipient's own checks; instead, the recipient receives a check printed by the creditor, made out to the creditor, using the debtor's checking account number information, which the debtor signs and returns. Thus, the debtor is freed from the need to use one of the debtor's own checks.

Independent claims 1, 27 and **55** all recite "(issuance of) an instruction to have a check issued that includes an offer to receive future funds via an electronic financial account" or similar. None of these features are taught by the combination of Starr and Thomson. The Office Action of 08/24/2004 admits that Starr does not disclose such technology; however, that Action indicates that Thomson does make such a disclosure.

However, Thomson does not disclose "instruction(s) to have a check issued that includes an offer to receive future funds via an electronic financial account". Instead, referring to the sections of Thomson cited in the Action, including specifically Fig. 1, it can be seen that Thomson discloses sending a pre-printed check to the debtor that can be signed and returned to the creditor. Thomson does not disclose a check which *sends an offer to receive future funds* via an electronic financial account.

Careful examination of the check itself disclosed by Thomson does not reveal any offers of any kind. In fact, neither Starr, nor Thomson provides an offer of any kind on a check. For example, Fig. 1C of Thomson shows a check in the bottom 1/3 of the figure. The check shown includes no offer at all, and certainly does not show an offer to send future funds by means of electronic funds transfer.

The Patent Office indicates that offers are made on another document (e.g. an invoice, such at that shown in the middle portion of Fig. 1C). However, the Applicant notes that none of these offers is *on a check* or any other type of negotiable instrument; instead, the offers are on the invoice or "bill". <u>Secondly, the Applicant notes that none of the offers provides for *receipt of future funds via an electronic financial account*</u>.

Accordingly, Thomson fails to remedy the defects of Starr, at least because Thomson fails to disclose elements recited in the Applicant's claims, including:

(1) Thomson fails to disclose offers to send future funds via an electronic account, and

(2) Thomson fails to disclose <u>any</u> offers on the check itself.

The Patent Office indicates that URLs are well-known. However, the Applicant notes that URLs are not recited in claims 1—8, 12—14, 27—30, 33—38 and 55. Accordingly, the issue of URLs is addressed below, in the argument associated with claims 24 and 47, wherein URLs are recited.

Therefore, for at least the above reasons, it is respectfully submitted that Starr and Thomson do not render obvious independent **claims 1, 27, 52, 53,** and **55.**

Claims 2—8, 12—14, 28—30 and 33—38 are allowable due to their dependence (direct or indirect) from claims 1 or 27, as well as for reasons associated with the elements recited in each claim. Accordingly, their rejection under 35 U.S.C. §103 should be withdrawn.

II. The Rejections Under 35 U.S.C. §103(a)

In the Office Action, claims 9—11 were rejected under 35 U.S.C. §103(a) over Starr (US 6,606,606) in view of Thomson (5,121,945) and further in view of Schrader (US 5,903,881). The Applicant respectfully traverses the rejection.

Claims 9—11 depend, indirectly, from claim 1. Therefore Claims 9—11 are allowable by virtue of this dependence, as well as for reasons recited in each claim. Moreover, the claims recite elements not seen in the combined three references.

Schrader discloses, particularly within the region cited by the Patent Office, an historical backdrop of on-line banking provided in the Background (Schrader, col. 1, line 5 through col. 5, line 57). Additionally, the Background in Schrader surmises that "it is desirable to provide on an online banking software product and system that tightly integrates bill payment, account management, and determination of current balances, into a single user interface display," (col. 5, lines 53-57). However, the Background fails to disclose the recited elements of claims 9—11.

Schrader additionally fails to teach or suggest the recited elements of claims 9—11 in the Summary (col. 5, line 60 through col. 7, line 14, a section which was cited in the rejection). The Summary summarizes the Schrader disclosure as "The integration and simultaneous presentation of the three different types of transactions, and two account balances in a single user interface presents a complete view of both financial institutional data (cleared transactions, and cleared balance) and customer data (transaction instructions, uncleared transactions and combined balance) on one screen," (col. 6, lines 38-44).

Accordingly, the descriptions provided by Schrader do not describe the participants of a transaction as they are recited in claims 9—11.

The Patent Office suggests that, while Starr and Thomson fail to disclose the elements recited by claims 9—11, that these elements are shown by Schrader. However, a careful reading shows that <u>Schrader does not disclose the elements of claims 9—11</u>. The Patent Office, on page 7 of the Office Action mailed 08/24/2004, only very generally points to nine (9) figures and seven (7) columns of text in Schrader, saying that within this large range of information the recited items are disclosed. The Applicant has reviewed the material cited by the Patent Office and has failed to find within that material the elements recited in the Applicant's claims. <u>If this rejection is to be maintained, the Applicant respectfully requests that specific locations within Schrader—upon which the Office relies in making rejections of the individual elements recited in claims 9, 10 and 11—be pointed out specifically and clearly, rather than in a general manner, so that a discussion of each of the recited elements in claims 9—11 may be undertaken</u>.

III. <u>The Rejections Under 35 U.S.C. §103(a)</u>

In the Office Action, 15—22, 39—45 and 52—53 were rejected under 35 U.S.C. §103(a) over Starr and Thomson, and in view of O'Leary, et al. (U.S. patent 6,609,113). The Applicant respectfully traverses the rejection.

Claims 15—22 depend, directly or indirectly, from claim 1, and are therefore allowable due to their dependence on a claim allowable for the reasons seen above. Similarly, **claims 39—45** depend, directly or indirectly, from claim 27, and allowable due to their dependence on a claim allowable for the reasons seen above.

Additionally, claims 15—22 and 39—45 recite elements not seen in their respective base claims, and these claims are allowable for these reasons also. While the O'Leary reference was cited to remedy the deficiencies of Starr and Thomson, O'Leary fails to do so.

O'Leary discloses a system and method to implement processing over the Internet of electronic funds transfer. In particular, this reference allows a financial service (e.g. the Chase Manhattan Bank) to assist a shopper in making payments for items sold over the Internet.

The rejection acknowledges the deficiencies of Starr with regard to all of the features recited in claim 15—22 and 39—45. Therefore, the rejection purports to append the teachings of O'Leary onto a base claim and intervening claims, which the rejection acknowledges are not taught by Starr. Further, the rejection *does not provide any suggestion of the motivation to combine the references cited*, other than to say that O'Leary performs steps that Starr and Thomson do not. Thus, the rejection fails to meet the required burden set forth in MPEP §2143. Therefore, it is respectfully submitted that there is no suggestion as to why references should be combined as indicated by the Patent Office. Accordingly, the rejection of claims 15—22 and 39—45 should be removed. Moreover, even when combined, O'Leary fails to remedy the defects of Starr and Thomson.

For example, **claims 19 and 43** are allowable because O'Leary fails to disclose "wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment." O'Leary discloses insufficient funds only once (C 16; L 22), referring to providing the user with an option to utilize a second account

if a first account has insufficient funds. Thus, O'Leary does not address "whether to honor the participants payment when the specified account has insufficient assets"; in fact, O'Leary requires the user to provide an account that does have sufficient assets and <u>does not address the issue of *whether to honor* an under-funded account</u>.

As a further example taken from among claims 15—22 and 39—45, **claims 20 and 44** are allowable because O'Leary fails to disclose "wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment." As seen above, O'Leary discloses only a mechanism by which the consumer may locate an account that does have the money. Accordingly, <u>no mechanism is taught by O'Leary to utilize a "*growing trust* model to determine whether to honor the payment" when the funds are not there</u>.

As a further example taken from among claims 15—22 and 39—45, **claims 21 and 45** are allowable because O'Leary fails to disclose "automatically accesses a line of credit". <u>In contrast, O'Leary mentions no such *automatic access* feature</u>.

As a still further example taken from among claims 15—22, **claim 22** is allowable because O'Leary fails to disclose "wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment". <u>In contrast, O'Leary mentions no such *notification* feature</u>.

Claims 52 and 53 are allowable for at least the reasons for which it has been shown that claims 1, 27 and 55 are allowable, and those arguments are incorporated herein by reference.

The method of claim 52 comprises, in part, "including on the check an offer to receive future funds via an electronic financial account with a pre-printed unique access code for the account." The method of claim 53 comprises, in part, "issuing a physical check...wherein the check includes an offer to utilize an account created within the electronic financial network and associated with the requesting participant to receive future funds." These recited elements are not seen Starr, Thomson or O'Leary. In particular, the only check seen in these references is in Fig. 1 of Thomson, which fails to disclose the particulars recited.

The Patent Office states generally that the elements are seen in O'Leary. However, <u>the Applicant fails to see the recited elements, and requests a more specific location to which to refer within O'Leary</u>.

Additionally, the Applicant respectfully submits that claims 52 and 53 are distinguishable over the references of record for at least the reasons set forth above regarding claims 1 and 27. O'Leary does not compensate for such deficiencies, nor is that assertion made in the rejection.

IV. <u>The Rejections Under 35 U.S.C. §103(a)</u>

In the Office Action, claims 23—25 and 46—48 were rejected under 35 U.S.C. §103(a) over Starr, Thomson, O'Leary and Schrader. The Applicant respectfully traverses the rejection.

Claims 23—25 depend, directly or indirectly, from claim 1, and therefore are distinguishable over Starr, Thomson and O'Leary for at least the reasons set

forth above regarding claim 1. Similarly, **claims 46—48** depend, directly or indirectly, from claim 27, and therefore are distinguishable over Starr, Thomson and O'Leary for at least the reasons set forth above regarding claim 27. Neither O'Leary nor Schrader compensates for such deficiencies, nor is that assertion made in the rejection. Further, the rejection does not provide any suggestion of a motivation to combine the references cited, other than to say that O'Leary and Schrader are able to accomplish what Starr is unable to. Thus, the rejection fails to meet the required burden set forth in MPEP §2143.

In particular, Schrader does not disclose the elements recited in claims 23—25 and 46—48. The Patent Office, on pages 11 and 12 of the Office Action mailed 08/24/2004, only very generally points to nine (9) figures and seven (7) columns of text in Schrader, saying that within this large range of information the recited items are disclosed. The Applicant has reviewed the material cited by the Patent Office and has failed to find within that material the elements recited in the Applicant's claims. If this rejection is to be maintained, the Applicant respectfully requests that the specific elements within Schrader, upon which the Office relies in making the rejection, be pointed out clearly, so that a discussion of each may be undertaken.

And further, neither Thomson nor Schrader provides a URL on the check, as recited in **claims 24 and 47**. For example, Fig. 1C of Thomson shows a check in the bottom 1/3 of the figure. The check includes no offer and no URL. Therefore, while URLs are known, providing a URL on a check is not shown by the prior art of record. Furthermore, a URL offering "instruction(s) … to receive

future funds via an electronic financial account" is also now shown by the prior art of record.

In summary, Starr, Thomson, O'Leary and Schrader simply do not disclose:

* the use of an "instruction to have a check issued that includes an offer to receive future funds via an electronic financial account";
* the use of a URL on a check;
* the use of a URL to convey an offer "to receive future funds via an electronic financial account"; and
* any motivation to combine such features (which are not shown).

These deficiencies are not remedied by any other art of record. Accordingly, claims 23—25 and 46—48 are allowable.

V. CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance. Please call if there are any issues which may be handled on the phone to save time.

Respectfully Submitted,

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